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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,636	03/23/2004	Jerald C. Seelig	619.706	2585

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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

07/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/806,636

**Applicant(s)**

SEELIG ET AL.

**Examiner**

Corbett B. Coburn

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 14-16, 18-62 and 64-67 is/are pending in the application.
- 4a) Of the above claim(s) 24-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5-10, 14-16, 18-23, 57, 61 and 67 is/are rejected.
- 7) ☒ Claim(s) 2-4, 58-60, 62 & 64-66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. At least claims 1-10 of this application conflict with claims 1-12 of Application No. 12/120,061. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. At least claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending

Application No. 12/120,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because they describe the same structure.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5-10, 14-16, 18-23 & 57, 61 & 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordman (US Patent Number 6,712,694) in view of Brown (US Patent Number 5,673,504).

**Claims 1:** Nordman teaches a gaming device including a housing (10A) with a plurality of walls that define a cavity. Nordman teaches at least one moveable indicator (80) associated with the housing & moving along a first predetermined path. There is a moveable indicator actuator (58B) configured to move the moveable indicator in a linear manner along a first axis. (Fig 3A) (The indicia move in a curvilinear fashion.) There is also a display device (60) with a plurality of indicia associated with the housing. There is a display device actuator (58A) configured to move the display device in a linear manner along a second axis, wherein the second axis is orthogonal to the first axis. (The indicia on the display device move in a curvilinear manner.) There is a one controller (38) in communication with the display device actuator and the moveable indicator

actuator. (Fig 2) The controller is configured to determine a game outcome, and to direct movement of the moveable indicator and the display device.

Nordman does not teach that the indicia are on a band of material. It is old and well known to place indicia on a moving band of material and it is equivalent to Nordman's display. Brown teaches a display device that makes use of a moving band of material. This moving band moves along a second predetermined path. The combination of Nordman and Brown is within the level of ordinary skill. Each element of the combination performs in the expected manner to yield predictable results. Combining known elements in a known manner to yield predictable results is considered obvious.

**Claim 5:** The indicia represent prizes a player may win.

**Claim 6:** Nordman teaches a free spin (Fig 1, 60). This is a game play prize.

**Claims 7 & 12:** Nordman teaches the invention substantially as claimed, but fails to teach vertical axes. As claims 8 & 13 make clear, the orientation of the axes is not a critical factor & is merely a matter of design choice.

**Claims 8 & 13:** Nordman teaches movement & rotation about a horizontal axis.

**Claim 9:** Nordman teaches indicia arranged on the display device in an  $m$  by  $n$  matrix, and  $m$  and  $n$  are integers. (Fig 5) It would be obvious place the indicia on a band as taught by Brown.

**Claims 10:** Nordman teaches the invention substantially as claimed, but fails to teach a display with a belt between rollers. Brown teaches a chassis a plurality of rollers (Abstract) attached to the chassis and an actuator (electric motor) coupled to the roller. At least a portion of the display device is wrapped around the roller. (Fig 3) The

actuator rotates the roller causing the display device to be rotated and move the indicia.

(Abstract)

A combination of Nordman & Brown would yield predictable results. A combination of known elements, each performing their usual function, by known methods to yield predictable results is obvious.

**Claims 14 & 15:** There is a positioning system (56) for determining at least one position of the moveable indicator & display device.

**Claims 16, 61:** Brown teaches a plurality of idler rollers (15 & 16) at least one drive roller (12); and a motor (17) in communication with the drive motor, wherein at least a portion of the display device is in contact with the idler roller and driver roller and rotates about the idler roller and the drive roller when the drive roller is actuated by the motor.

**Claim 18:** Nordman teaches an embodiment in which, the moveable indicator actuator includes a motor in communication with a worm gear, the moveable indicator being affixed to the worm gear. (Fig 8)

**Claim 19:** The gaming device may be configured as a primary game. Col 3, 1-5 indicates that the game uses the indicated symbol "to provide a number of base game credits." This indicates that it may be used as a base game.

**Claim 20:** The gaming device may be configured as a bonus game in association with a primary game. (Col 4, 26-36)

**Claim 21:** Nordman teaches a slot machine game as the base game.

**Claims 22 & 23:** Nordman teaches the invention substantially as claimed, but fails to teach the claimed arrangement of indicia. However, the arrangement of indicia in a slot machine is a matter of design choice well within the level of ordinary skill.

**Claims 57:** The combination of Nordman & Brown teaches the claimed invention with Nordman's arrow (80) being the indicator & Brown's tape or band substituting for Nordman's display (100). As pointed out above, the orientation of the various elements is a matter of design choice.

**Claim 67:** Nordman's arrow moves from left to right & Brown's belt scrolls up & down. Therefore, the first axis is orthogonal to the second axis.

#### ***Allowable Subject Matter***

7. Claims 2-4, 58-60, 62 & 64-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: While the art is replete with devices that allow the player to have some control over the position of game elements (i.e., skill stop mechanisms, etc.), Examiner believes that combining these references with Nordman & Brown would require the exercise of impermissible levels of hindsight.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/  
Primary Examiner  
Art Unit 3714